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AUG 05 2004

OFFICE OF PETITIONS

In re Application of :
Borrego Bel et al. :
Application No. 10/707,634 : DECISION REFUSING STATUS
Filed: December 26, 2003 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 813ES :
:

This is in response to the petition under 37 CFR 1.47(a), filed on May 23, 2004.¹

The petition is dismissed.

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on December 26, 2003, without an executed oath or declaration. Accordingly, on March 5, 2004, the Office mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring an executed oath or declaration and a surcharge for its late filing. On April 23, 2004, applicants submitted a declaration executed by two of the

¹ To avoid abandonment of the application, it is necessary for applicants to obtain an extension of time within the first month. Accordingly, the \$110.00 extension of time fee will be charged to Deposit Account No. 50-2438, as authorized.

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three joint inventors. In response, on May 6, 2004, the Office mailed a "Notice of Incomplete Reply (Nonprovisional)," stating that applicants' reply of April 23, 2004 had been entered into the application; however, the signature of Alex Subirates Sole was missing. The period for reply remained as set forth in the Notice of March 5, 2004. Extensions of time to reply were available.

On May 23, 2004, applicants filed the present petition. In the Statement of Facts, Bruce E. Harang states the assignee's Spanish patent counsel couriered a letter requesting Sr. Subirates Sole to execute a declaration for the above-identified application. The letter was returned as undelivered. A second copy of the letter was delivered to Sr. Subirates Sole on May 5, 2004, but he refused to respond. A copy of the front and back of the delivery confirmation receipt and copies of emails between Mr. Harang and the Spanish patent counsel are included with the present petition.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicants lack item (1) as set forth above.

As to item (1), it is unclear from the record whether Sr. Subirates Sole was presented with the complete application papers. Unless Sr. Subirates Sole was presented with a complete copy of the application papers, including the specification, claims and drawings, he could not attest that he has "reviewed and understands the application papers," and therefore, could not sign the declaration that he was given. Accordingly, applicants failed to show or provide proof that the nonsigning inventor has refused to sign the declaration. See MPEP 409.03(d). To show that the inventor has refused to join in the application, applicants must show that complete copies of the application papers, including the specification, claims and drawings, were presented to Sr. Subirates Sole, personally or through his designated representative, and that he did not respond to the request that he sign the declaration.

Further correspondence with respect to this matter should be addressed as follows and to the attention of **Christina Tartera Donnell, Senior Petitions Attorney**:

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By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the
undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions